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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,322	08/10/2001	Patricia Imbach	4-30822A	4697

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EXAMINER

BERCH, MARK L

ART UNIT PAPER NUMBER

1624

DATE MAILED: 11/05/2002

/1

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n N .

09/927,322

Applicant(s)

IMBACH ET AL.

Examiner

Mark L. Berch

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See memo.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See memo.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-11, 18-21, 23 and 24.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: PTO-892

Mark L. Berch  
Primary Examiner  
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#### DETAILED ACTION

The traverse on issue A is unpersuasive. Claim 3 provides that the choices for R4 depends on what choice has been selected for R1; specifically, whether R1 is of choice  $\alpha$  on one hand, or  $\beta$ ,  $\gamma$ , or  $\delta$  on the other hand. No such concept exists in the specification. The material that applicants point to on page 27, lines 1-3 refers to the definition of R5, not R4.

With regard to point 1, applicants inability to answer the question posed in the Final Rejection is clear evidence that the term is indefinite. Applicants either intend to have the same definition used everywhere or they do not. Second, if they do not, what is the broader definition, the one which is broader than that provided in the specification?

With regard to point 2 (original point 6), the response is not at all directed to the actual rejection. The problem is not "to distinguish an aliphatic radical from an aliphatic acyl radical." The problem is as follows: Applicants, in arguing that the  $\alpha$ 1 definition is not indefinite, stated the following: " "Aliphatic" does not embrace aliphatic acyl". Such a statement is factually incorrect, unless applicants are using a very unconventional definition of aliphatic. The current argues that the two terms differ from each other, which is true, but that does not get at the difficulty. If applicants continue to believe that " "Aliphatic" does not embrace aliphatic acyl" is correct, they are invited to give an example of an aliphatic acyl which is not aliphatic.

With regard to point 4, one of ordinary skill in the art knows that a hydrocarbyl radical is one composed of just C and H. To refute applicants' assertion that the page 10 material "utilizes the usual meaning of hydrocarbon" there is cited the four references on the PTO-892.

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With regard to point 6, the traverse is unpersuasive. Because applicants have left out the locant, the material in braces could be on the N, or it could be on the ring. It is not "standard nomenclature" to omit a locant where there is more than one place where a substituent can be present. Applicants should just put the locant in and fix the names. Note for example, that the 3<sup>rd</sup>, 4<sup>th</sup>, 5<sup>th</sup> and 6<sup>th</sup> from last species in claim 11 all do have the locant in front of the material in braces. That is the correct standard nomenclature.

With the entry of the amendment, the remaining points are overcome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch  
Primary Examiner  
Art Unit 1624

October 30, 2002